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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,646	08/18/2000	Anthony J. Cipolla	13072	6936

7590

04/23/2003

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EXAMINER

WILSON, JOHN J

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 04/23/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/641,646

Applicant(s)

CIPOLLA ET AL.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49-51 is/are allowed.
- 6) ☒ Claim(s) 1 and 6-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6-37 and 42-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the relevant art to make and use the claimed invention. The present claims are directed to an embodiment of one light-generating device positioned on the light base to shine light into an archway space, which is arranged to output light in a lobe that overlaps light lobes of other devices. The disclosure as originally filed does not teach and does not enable one of ordinary skill in the art to make and use such an embodiment. How can a single device overlap the lobes of other devices? In the case of claim 43, how can one device combine light with other lobes?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6-37 and 42-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The present claims are directed to an embodiment of one light-generating device positioned on the light base to shine light into an archway space, which is arranged to output light in a lobe that overlaps light

Art Unit: 3732

lobes of other devices. It is not clear how it is possible for a single device to overlap or combine with the lobes of other devices? As to claim 42, this claim refers to an alternative embodiment without clearly stating that the claim is directed thereto, making it unclear as to how the claim relates to the single device embodiment. Applicant must make it clear that a plurality of lobes are being claimed before modifying them.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-19, 24-26, 29, 32-34, 38, 40 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (WO 99/37236). Jensen shows a light base 32 having a curved surface and a plurality of light generating devices 40. The output light of Jensen will inherently overlap and from a combined field. The overlapping light will overlap in an infinite number of surfaces including a convex surface of relatively uniform intensity. The specific range of intensity used is an obvious matter of choice in the degree of a known parameter for light emitting devices to one of ordinary skill in the art. The specific type of light generating devices used is an obvious matter of choice in well known light producers to the skilled artisan. As to claim 14, to use a lens with a light emitting device is well known in the art, and therefore, an obvious matter of choice to one of ordinary skill in the art. As to claim 26, the process of

Art Unit: 3732

assembly is an obvious matter of choice in the process used to form an obvious structure. As to claims 32 and 33, Jensen emits visible light. As to claim 37, to call the output a lobe is an obvious matter of choice in defining a specific area of the overall light output.

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (WO 99/37236) in view of Kipke et al. Jensen shows the structure described above, however, does not show the use of LED's. Kipke teaches using LED's at the base. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of LED's as shown by Kipke in order to place the source in the desired location.

Claims 27, 28, 39, 41, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (WO 99/37236) in view of Kipke et al as applied to claim 20 above, and further in view of Kennedy (711). The above combination does not show a cooling fan nor blue light. Kennedy teaches using a cooling fan as shown and teaches the use of blue light, column 3, line 43. It would be obvious to one of ordinary skill in the art to modify the above combination to include a cooling fan to cool the light emitters and to include the use of blue light in order to supply the desired type of light as shown by Kennedy.

Art Unit: 3732

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (WO 99/37236) in view of Rhoades (851). Jensen shows the structure described above, however, does not show positioning means. Rhoades teaches positioning means in the form of a bite block. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of positioning means as shown by Rhoades in order to position the device in the desired location.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (WO 99/37236) in view of Nikodem (854). Jensen shows the structure described above, however, does not show a flexible base. Nikodem teaches a flexible base 12. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of a flexible base as shown by Nikodem in order to position change the shape as desired.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (WO 99/37236) in view of Cipolla (159). Jensen shows the structure described above, however, does not show a filter for blocking light. Cipolla teaches a filter 127. It would be obvious to one of ordinary skill in the art to modify Jensen to include the use of a filter as shown by Cipolla in order to stop undesirable light, column 5, lines 27-31.

Claims 1, 6-19, 24-26, 29, 32-34, 38, 40 and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare (5316473). Hare shows a light base

Art Unit: 3732

11c forming an archway and a light generating device as shown that shines light into the archway and can deliver light at an intensity of 250 milliWatts/cm², column 7, line 24.

Hare also teaches stronger intensities, however, does not state a distance at which the intensity occurs. It would be obvious to one of ordinary skill in the art to deliver the intensity at a desired distance in order to fully activate the light activated compound.

Further, the light intensity will inherently fall off as distance from the source increases.

The specific range of intensity of light at a range of distance is an obvious matter of choice in known parameters to one of ordinary skill in the art in order to deliver the desired intensity to obtain a desired result.

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare (5316473) in view of Kipke et al. Hare shows the structure described above, however, does not show the use of LED's. Kipke teaches using LED's at the base. It would be obvious to one of ordinary skill in the art to modify Hare to include the use of LED's as shown by Kipke in order to place the source in the desired location.

Claims 27, 28, 39, 41, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare (5316473) in view of Kipke et al as applied to claim 20 above, and further in view of Kennedy (711). The above combination does not show a cooling fan nor blue light. Kennedy teaches using a cooling fan as shown and teaches the use of blue light, column 3, line 43. It would be obvious to one of ordinary skill in the art to modify the above combination to include a cooling fan to cool the light emitters and to

Art Unit: 3732

include the use of blue light in order to supply the desired type of light as shown by Kennedy.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare (5316473) in view of Rhoades (851). Hare shows the structure described above, however, does not show positioning means. Rhoades teaches positioning means in the form of a bite block. It would be obvious to one of ordinary skill in the art to modify Hare to include the use of positioning means as shown by Rhoades in order to position the device in the desired location.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare (5316473) in view of Nikodem (854). Hare shows the structure described above, however, does not show a flexible base. Nikodem teaches a flexible base 12. It would be obvious to one of ordinary skill in the art to modify Hare to include the use of a flexible base as shown by Nikodem in order to position change the shape as desired.

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare (5316473) in view of Cipolla (159). Hare shows the structure described above, however, does not show a filter for blocking light. Cipolla teaches a filter 127. It would be obvious to one of ordinary skill in the art to modify Hare to include the use of a filter as shown by Cipolla in order to stop undesirable light, column 5, lines 27-31.

Art Unit: 3732

Allowabl Subj ct Matt r

Claims 49-51 are allowed.

Response to Arguments

Applicant's arguments filed November 6, 2002 have been fully considered but they are not persuasive. The present claims are directed to an embodiment of a single light device, and as such, are met by the above applied prior art.

Conclusion

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



**John J. Wilson
Primary Examiner
Art Unit 3732**

jjw

April 18, 2003

Fax (703) 308-2708

Work Schedule: Monday through Friday (flex time)